elect, as a consequence of the election of Group I, the mouse SOCS I species as represented by SEQ ID NO: 3 and nucleic acid molecules encoding SEQ ID NO: 4.

REMARKS

In the Office Action dated September 24, 1999, the Examiner has set forth a requirement for restriction under 35 U.S.C. §121 as follows:

Group I.	Claims 1-15, drawn to an isolated nucleic acid molecule comprising a sequence encoding a SOCS box motif, classified in class 536, subclass 23.1.
Group II.	Claims 16-30, drawn to an isolated protein comprising a SOCS box motif, classified in class 530, subclass 350.
Group III.	Claim 31, drawn to a method of modulating levels of a SOCS protein in a cell, classified in class 514, subclass 12.
Group IV.	Claim 32, drawn to a method of modulating signal transduction in a cell, classified in class 514, subclass 12.
Group V.	Claims 33-40, drawn to a method of influencing interaction between cells, classified in class 514, subclass 12.

In support of the present restriction requirement, the Examiner has alleged that the subject matter defined by the claims of the present invention represents five separate and distinct inventions. Specifically, the Examiner contends that Group I and Group II are related but constitute distinct inventions, since the polypeptides of Group II, encoded by

nucleic acid molecules of Group I, can be made by another materially different process, such as synthetic peptide synthesis or purification from the natural source. The Examiner states that the nucleic acid molecules of Group I can also be used in processes other than the production of the polypeptide, such as hybridization assays. Further according to the Examiner, Group I is related to, but distinct from, Groups III-V as product and process of use, since the nucleic acid molecules of Group I can be used in materially different process such as nucleic acid hybridization assays. The Examiner has further alleged that Group II is unrelated to Groups III-V, since the Examiner contends that the polypeptides of Group II are not used in the methods of Groups III-V. Moreover, the Examiner has alleged that Groups III-V are unrelated to each other since each method has different purposes. The Examiner further states that the inventions have acquired a separate status in the art as evidenced by the separate classification, and thus, require independent searches that would impose a serious burden on the Examiner.

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect to prosecute the subject matter of Group I, Claims 1-15 directed to nucleic acid molecules comprising a sequence encoding a SOCS box motif. Applicants further provisionally elect the mouse SOCS I species as represented by SEQ ID NO: 3 and nucleic acid molecules

encoding the mouse SOCS I protein (SEQ ID NO: 4). Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter in this application.

However, pursuant to 37 C.F.R. §§ 1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

An Examiner's authority to require restriction is defined and limited by statute:

> If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

35 U.S.C. § 121, first sentence (emphasis added).

The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independence and distinctness, a restriction requirement is unauthorized.

In the present application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement. Specifically, Applicants submit that Group I is related to Group II, as the Examiner has conceded, since the nucleic acid

molecules of Group I encode the polypeptides of Group II. Thus, Group I and Group II are not independent of each other.

Furthermore, Applicants submit that Group I is related to and not independent of Groups III-V, since the methods of Group III-V all require the use of the nucleic acid molecules of Group I.

Moreover, contrary to the Examiner's contention that Group II is unrelated to Groups III-V, the methods of Groups III-V are achieved by modulating the levels and/or the activities of the polypeptides of Group II by using the encoding nucleic acid molecules of Group I. Thus, Applicants submit that Group II is related and not independent of Groups III-V.

Applicants further submit that Groups III, IV and V are also related to and not independent of each other. Even though the effects of the methods of each group are different, all these effects are achieved by modulating the levels and/or the activities of the polypeptides of Group II by using the encoding nucleic acid molecules of Group I.

The courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention,

regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicants are required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C.

§ 121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986). In Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) the court held that § 121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public interest in the legitimacy of issued patents, Applicants respectfully urge the Examiner not to require restriction in cases such as the

present application wherein various aspects in a unitary invention are claimed.

In view of the foregoing comments, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,

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